

## **REMARKS**

### **I. Status of Claims**

Claims 1-49 are currently pending in this application. Claims 6, 7, 8, 27, 28, and 29 stand objected to as being dependent upon a rejected base claim, but allowable if rewritten into independent form. Claims 11-17 are allowed. Claims 22, 23, 26, 39, 40, 42, 44, 47, 48, and 49 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,105,334 to Monson ("the Monson patent"). Claims 24, 25, 30, 31, and 43 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Monson patent. Claims 32-38, 41, 45, and 46 stand rejected as being obvious over the Monson patent in view of U.S. Patent No. 6,112,488 to Olson et al. ("the Olson patent"). Claims 1, 2, 3, 4, 5, 9, 10, 18, 19, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Monson patent in view of U.S. Patent No. 6,561,762 to Horng ("the Horng patent").

### **II. The Phrase "Preassembled Integral Unit" Defines a Structural Limitation**

As noted above, all of the rejections in the December 27, 2004 Office Action are based on the Monson patent. However, Applicants believe that the Monson patent does not fairly disclose or suggest the invention claimed in this application.

The Monson patent does not disclose or suggest a *preassembled integral unit* adapted to be installed behind a surface opening of a wall assembly, as called for by the claims of the present application. By forming this structure, an advantageous relationship between the claimed lighting fixture and fire-resistant housing can be constructed and tested in the factory and before installation in the building. Therefore, the minimum amount of material can be used, and the combination can obtain a pre-approved fire-rating, thereby eliminating the need for extensive on-site fire code inspection.

The Action has accepted the fact that the Monson patent does not disclose or suggest a preassembled integral unit. To support the rejection, however, the Action alleges that "the phrase preassembled is considered as a method of forming a device, which is not germane to the issue of patentability of the device itself."

The Action's position on this point is contrary to reasonable logic, to reasonable claim interpretation, and to established case law, and thus should be withdrawn. In *Petersen v. Fee Int'l, Ltd.*, 381 F.Supp. 1071, 1077-78, 182 U.S.P.Q. 264, 268 (W.D. Ok. 1974) (attached as Exhibit A), the court construed claims relating to an adjustable wrench. Claim 2 required that certain pieces of the wrench be "preassembled." The defendant argued that the "the word 'preassembled' is a process limitation, not a structural limitation." *Id.* The court rejected this argument, and explained that "preassembled" "requires that the parts be connected together in the specific relationship defined in the claim and is therefore a structural limitation." Here, just like in *Peterson*, the word "preassembled" requires that the specified parts be connected together in a specific relationship, and therefore, is a structural limitation.

Thus, under established case law and logic, ignoring the term "preassembled" is believed clearly improper. When properly interpreted, the claims require a preassembled integral unit—i.e. a unit preassembled in the specific relationship defined in the claims. Neither the Monson patent, nor the other references, discloses or suggests such a preassembled integral unit. Accordingly, the claims rejected over Monson are allowable, and reconsideration and withdrawal of the rejections is respectfully requested.

### **III. Claims 32-38, 41, 45, 46 Relating to the Fire-Resistant Gasket**

Independent claim 32 and its dependent claims 33-38, as well as dependent claims 41 and 46 (but not dependent claim 45), all recite the addition of a generally fire-resistant gasket adapted to substantially surround the opening of the fire rated building structure and adapted to engage the fire rated building structure. This structure is located in a particular place and advantageously helps to improve the fire-rating of the overall fixture after it is placed on the building structure.

These claims 32-38, 41 and 46 are rejected under 35 USC 103 over the Monson patent in view of the Olson et al. patent (6,112,488). The basis for the rejection is that it would be obvious to use the gasket of Olson et al. in the Monson patent.

Applicants respectfully believe that this rejection is incorrect and improper, and is merely based on a hindsight reconstruction of the prior art only in view of Applicants' disclosure. The Monson patent very conspicuously does not use a gasket, including a fire-resistant gasket, as set forth in the claims substantially surrounding the opening of a fire rated building structure and

adapted to engage that structure. Adding a gasket in that location in view of the general teaching of use of a gasket in Olson et al. is not at all fairly suggested by the references, is merely based on hindsight, and is not at all obvious.

Therefore, claims 32-38, 41, and 46 are believed clearly allowable.

**IV. Objections to Claims and Allowable Claims**

Applicants appreciate the indication that claims 6, 7, 8, 27, 28, and 29 would be allowable if rewritten into independent form. Applicants have amended claims 6 and 27 to place them into independent form, and assert that they are now allowable. Claims 7-8 and 28-29 depend from claims 6 and 27, respectively, and are therefore also allowable. Applicants appreciate the allowance of claims 11-17.

**V. Applicant's Additional U.S. Patent 6,838,618**

As noted in the Supplemental Information Disclosure Statement filed concurrently herewith, Applicants' previously co-pending application 10/702,725, which is a continuation of this application Ser. No. 10/066,310, issued January 4, 2005 as U.S. Patent 6,838,618. This patent was found patentable over the Monson patent, as was Applicants' prior patent 6,357,891.

**VI. Conclusion**

In view of the above, it is believed that claims 1-49 are clearly allowable, the above-identified application is in condition for allowance, and notice to that effect is respectfully requested. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

Dated: June 27, 2005

Roylance, Abrams, Berdo & Goodman, L.L.P.  
1300 19<sup>th</sup> Street, N.W., Suite 600  
Washington, D.C. 20036-1649  
(202) 659-9076



Alfred N. Goodman  
Reg. No. 26,458  
Attorney for Applicants